

to 9 have not been rewritten in independent form but rather have been made dependent upon new Claim 10.


In view of these amendments, it is respectfully urged that the Examiner's rejections of Claim 1, 3, 4, and 6 under 35 U.S.C. 112, ¶1 and ¶2 and additional rejection of Claim 4, under 35 U.S.C. 101, should be withdrawn and should not be applied to new Claims 10-12.

CLAIM 1 (new Claim 10):

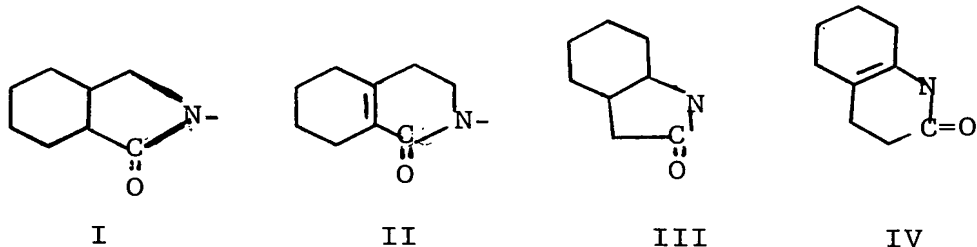
The Examiner has indicated that Claim 1 is vague and indefinite in the definition of X, that the meaning of "or unsaturated" is unclear, and further that it is not seen how the definition of X covers the hexahydroisoindoline or the octahydroisoquinoline compounds disclosed.

It is urged that Claim 10, which replaces Claim 1, more clearly defines X and it is respectfully requested that the Examiner's rejection of Claim 1 not be applied to Claim 10.

Claim 10 as written more specifically points out the definition of X. As disclosed at page 2 of the specification, X is defined as having both a cycloalkyl moiety and an alkyl moiety. Further, it is clear that the cyclo-moiety can have from 5 to 7 carbon atoms, can be substituted with methyl groups, can be saturated, or can be unsaturated.

Consequently, given the definition of X as described above, the group X  N- can consist of for example

the following structural formulae:



In examples I and III, the cycloalkyl moiety contains 6 carbon atoms whereas the alkyl moiety contains 1 carbon atom; support for structure I, the hexahydroisoindoline is given in Example 7 of the specification at page 15.

In structures II and IV, the cycloalkyl moiety again has 6 carbon atoms, here however, as is evident from the double bond, the ring is unsaturated; further, the alkyl moiety has 2 carbon atoms. Support for structure II, the octahydroisoquinoline, is found in Example 6 of the specification at page 14.

It is urged that the definition of X as claimed in Claim 10, is now clear and specific and it is requested that the Examiner not apply the rejection of Claim 1 thereto.

CLAIM 3 (new Claim 11):

Turning now to the Examiner's rejection of Claim 3 as being vague and indefinite in "medicaments based on . . .", it is urged that new Claim 11 distinctly claims the subject matter which the applicants regard as their invention.

Claim 3 has been redrafted as new Claim 11 defining a pharmaceutical composition in a form more conventional with U.S. patent practice reciting an active component and a carrier therefor. Support for this is found in the specification at page 9, ¶ 1. Thus, it is respectfully requested that the Examiner's rejection of Claim 3 not be applied to Claim 11.

CLAIMS 4 and 6 (new Claim 12):

The Examiner has rejected Claim 4 indicating that use is not a category of invention which can be claimed as such, and Claim 6, dependent upon Claim 1 was rejected ostensibly because of its dependency upon a rejected claim. Accordingly, the claims have been redrafted as Claim 12 so as to claim a process for the use of a compound as claimed in new Claim 10. It is urged that the claim as rewritten is now in compliance with the requirements of § 101 and therefore overcomes the Examiner's rejection. It is respectfully requested that the Examiner's rejection be withdrawn and not applied to Claim 12.

CLAIMS 7 to 9:

The Examiner has indicated that Claims 7 to 9 are allowable if rewritten in independent form. In view of the fact that it is urged that Claim 1 has been rewritten as Claim 10 so as to overcome the Examiner's rejection thereto, it is believed that Claims 7 to 9, dependent upon new claim 10 are now in allowable form. It is respectfully requested that the Examiner withdraw his objection.

CLAIMS 2 and 5:

Claims 2 and 5, drawn to non-elected subject matter under a requirement for restriction, have been cancelled to facilitate passage of this application to issue. However, the cancellation of these claims is not to be construed as an abandonment of their subject matter and the applicants expressly reserve the right to file one or more divisional applications to this subject matter.

References A through E have been cited by the Examiner to show the state of the art but have not been applied by the Examiner to the presently claimed invention.

Counsel has been informed that the following references have been cited against corresponding applications filed outside the United States:

- i) Published French patent application:  
2,085,759 corresponding to US Patent No.  
3,819,633 (Reference E) cited by the  
Examiner to show the state of the art;
- ii) Published European patent application:  
79102066.2 corresponding to US patent No.  
4,282,239;
- iii) Published German Patent Application 1,670,700  
which has been cited and discussed on page 8  
of the disclosure;
- iv) Published German Patent Application 2,103,118  
corresponding to US Patent No. 3,962,244.

The Examiner already has a copy of i); a copy of ii) is enclosed; copies of iii) and iv) will be forwarded in due course.

This opportunity is taken to thank the Examiner for specifically acknowledging receipt of the certified copy of German application P29 51 135.1 filed December 29, 1979 that was attached to the application as filed to substantiate the claim to priority made in the declaration.

Entry of the amendments, favorable reconsideration of Claims 7 to 9, and allowance of the application with Claims 7-12 are requested.

Respectfully submitted,

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